

**REMARKS**

Claims 10-16 are all of the claims pending in the application<sup>1</sup>; claims 10-12 are rejected and claims 13-16 are objected to.

Claim 16 has been amended to correct its dependency.

No new matter has been added. Entry of this amendment is respectfully requested.

**I. Claim Rejections Under 35 U.S.C. § 102(b) - Anticipation**

At paragraph 3 of the Office Action, claims 10 and 12 are rejected under 35 U.S.C. §102(b) as being anticipated by Jones et al. (WO 99/57143).

As noted by the Examiner, Jones et al. (EP1077219) has been used as the translation of the Jones et al. (WO99/57143) document.

The Examiner contends that Jones et al. teaches a method for determining whether a selected DNA molecule encodes a gene expression region, and further states that the method of Jones et al. comprises the two required steps recited in claim 10 of the present application. The Examiner cites the abstract, and columns 19-23, paragraphs 72-84 of Jones et al. (EP1077219), and notes that the selected DNA molecule is EST W17142.

The Examiner also contends that Jones et al. teaches the limitations of claim 12, wherein RNA transcripts are screened via PCR and the PCR primers are derived from the selected DNA molecule (paragraph 73, EP1077219).

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<sup>1</sup> Applicants respectfully note that while the status of the pending claims is correctly set forth on the Office Action Summary sheet as claims 10-16, paragraph 1 of the Office Action incorrectly lists claims 11-18 as pending in the application.

Applicants note that claim 10 of the present invention recites a method for determining whether a selected DNA molecule encodes a polypeptide that is expressed in a cell, based on the presence of corresponding mRNA. Although the sequence of the selected DNA molecule is known, whether the selected DNA is expressed is not known prior to conducting the method recited in the claim.

In contrast, the selected DNA molecule taught by Jones et al. is an “expressed sequence tag” or “EST,” which by definition corresponds to genomic DNA that is expressed. (An EST is derived from a cDNA library, which in turn is derived from mRNA). Specifically, Jones et al. teaches the screening of a cDNA library, using probes derived by PCR with primers based on the sequence of an EST of interest, in order to obtain the corresponding full-length cDNA. Thus, prior to conducting the method disclosed in Jones et al., it is already known that the selected DNA molecule corresponds to a gene expression region. Therefore, Jones et al. does not teach a method for determining whether a selected DNA molecule is expressed, as in the claims of the pending application.

Furthermore, whereas claims 10 and 12 of the present invention recite the screening of RNA transcripts, Jones et al. discloses the screening of a cDNA library. Thus, the present invention does not require any of: a nucleotide sequence encoding a known amino acid sequence, a cDNA database, or screening of a cDNA library using a PCR amplification product as a probe, as disclosed in Jones et al.

Accordingly, Applicants respectfully assert that claims 10 and 12 are not anticipated by Jones et al. as this document does not teach each element of the rejected claims. Applicants respectfully request reconsideration and withdrawal of this rejection.

If the Examiner feels that a telephonic interview would be helpfully in further discussing the differences between the claimed invention and the disclosure of Jones et al., he is requested to contact the undersigned at the telephone number provided below.

**II. Claim Rejections Under 35 U.S.C. § 103(a) - Obviousness**

At paragraph 6 of the Office Action, claim 11 is rejected under 35 U.S.C. §103(a) as allegedly being obvious over Jones et al. (WO 99/57143).

The Examiner contends that Jones et al. teaches all of the limitations of claim 11, except that the reference does not explicitly teach an embodiment wherein the selected DNA molecule consists of from 100-200 nucleotides.

Applicants refer to the comments above regarding the rejection of claims 10 and 12 as being anticipated by Jones et al. For the same reasons discussed above, claim 10 is not taught or suggested by Jones et al. As claim 11 merely defines one feature of the method recited in claim 10, claim 11 is also not taught or suggested by Jones et al.

Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection.

**III. Conclusion**

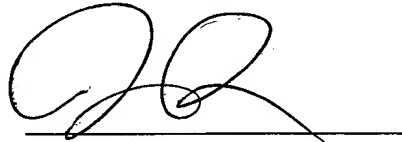
In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

AMENDMENT UNDER 37 C.F.R. §1.116  
U.S. Appln. No. 09/904,557

Q65441

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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